

20. An apparatus according to claim 19 wherein said permitting means further comprises an industry standard personal computer.

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REMARKS

The amendments reflected above and following remarks are submitted in response to the Official Action of the Examiner mailed April 15, 2002. Having addressed all objections and grounds of rejection, Claims 1-20, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

The Examiner has rejected Claims 1-4, 6-9, and 16-18 under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,256,624, issued to Pollard et al (hereinafter referred to as "Pollard"). This ground of rejection is respectfully traversed.

"It is axiomatic that for prior art to anticipate under §102 it has to meet every element of the claimed invention, and that such a determination is one of fact". *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81, 90 (Fed. Cir. 1986). The rejection is respectfully traversed because Pollard does not meet every element of the claimed invention.

Claim 1 is limited by:

- 1) user terminal which displays a report;
- 2) server responsively coupled to said user terminal via said publically accessible digital communications network; and
- 3) server which spools said report for future delivery at a predetermined time.

Pollard does not contain any of these elements.

As to element 1) above, the Examiner cites column 1, lines 44-46, column 4, lines 63-66. The first citation states:

These delivery systems may include private or public (sic) (e.g., the U.S. Postal Service) parcel delivery systems and Internet communication services.

The second citation states:

Information reports may be delivered through various delivery systems, including Internet communication services, private parcel delivery services, and the U.S. Postal Service.

Clearly, neither of these citations discloses a "user terminal which displays a report".

Similarly, in an attempt to show the second limitation, the Examiner cites system delivery 190 of Figure 1 and column 11, lines 43-50. Column 11, lines 43-50 states:

After completion of the insertion process, the report production facility 160 then transports the information reports to a delivery system 190 via a report transfer system 180 (e.g., truckling service) for distribution to the report recipients. As noted above, although the present invention is applicable to varied distribution

methods, the inventive method is particularly advantageous when the delivery system 190 is the U.S. Postal Service. (Emphasis added)

To say that "a document assembly facility 160 is coupled to the U.S. Postal Service via a trucking service" is the same as a "server responsively coupled to said user terminal via said publically accessible digital communications network" is more than clearly erroneous; it is bizarre.

As to the third limitation, "server which spools said report for future delivery at a predetermined time", the Examiner states:

an administrative module within said server which spools said report for later electronic delivery to said terminal at a predetermined time (see discussion of the scheduler, col. 8, lines 11-46; see also col. 13, line 53 through col. 14, line 42).

Scheduler 114 is located within computing system 110 (see Fig. 1), not within report production facility 160, which the Examiner has already termed "the server". As a result, the finding with regard to this element is both clearly erroneous (i.e., does not meet the limitation) and incorrect as a matter of law (i.e., Examiner has confused the structure on which he has read the previous limitation).

As a result of Pollard failing to teach each of the elements of Claim 1, the rejection of Claim 1 and all claims depending therefrom is respectfully traversed.

Claim 2 is a dependent claim which is further limited by a "plurality of user terminals which display said report and wherein said server electronically delivers said report to said plurality of user terminals". Because Pollard does not have a single "user terminal", it certainly cannot have a plurality of user terminals. However, instead of addressing the limitations of Claim 2, the Examiner mysteriously states:

Regarding claims 2 and 7, Pollard et al. additionally teaches a data processing environment and apparatus wherein said server electronically delivers said report to a plurality of user terminals (see discussion of the delivery of information reports via Internet communication services, col. 1, lines 44-46 and col. 4, lines 63-66; see also col. 1, lines 18-32). (emphasis added)

There is clearly no teaching of the electronic delivery of reports from any "Internet communication services". To be sure, Pollard mentions that reports may be delivered through various delivery services, including Internet communication services. However, the undersigned receives written monthly reports delivered via AOL Internet communication service which arrive through the U.S. Postal Service. Therefore, electronic delivery of a report is not inherent even from an Internet communication service.

Furthermore, the Examiner has indicated above that the claimed "server" element is found within Pollard as "report production facility 160". It is strenuously asserted that one of ordinary

skill in the art would not find that "report production facility 160" teaches electronic delivery of reports via a "publicly accessible digital data communication network" in accordance with the requirements of MPEP 2121, which reads in part:

"In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'.... ."

In re Hoeksema, 399 F.2d 269, 158 USPQ 596 (CCPA 1968).

In fact, "report production facility 160" teaches one of skill in the art to produce printed, hard copy reports. Column 11, lines 16-18, states:

The printed information reports are then transferred to an inserted 168 for insertion into an envelope prior to distribution.

It is inconceivable using current day technology that one could deliver these printed, hard copy reports in an electronic fashion. Thus, the rejection of Claim 2 and claims depending therefrom is respectfully traversed.

Claim 4 is a dependent claim wherein the "server" is further limited by a "repository" which includes "space for storage of said report". In making his rejection the Examiner refers to report output file 122. It is not clear whether report output file 122 stores any complete report rather than just a portion of various

reports. However, it is clear that report output file 122 is not located within report production facility 160, which the Examiner has equated with the "server" of the claimed invention. To further highlight these distinctions, Claims 4, 8, and 18 have been amended to indicate that the report is stored in "final form". Thus, the rejection of Claim 4 and claims depending therefrom is respectfully traversed.

Claims 1-5 and Claims 6-10 are all apparatus claims having similar, though not identical, limitations. It is unclear to what extent the Examiner has separately addressed these different claim groups. However, given the pending rejections, the arguments presented above are applicable to Claims 6-10, as well as Claims 1-5.

Claims 16-20, on the other hand, contain means-plus-function limitations. The position of the courts is well established that the Examiner must examine such claims in a different manner. Quoting the Court of Appeals for the Federal Circuit from *In Re Donaldson*, 29 USPQ 1845 (Fed. Cir. 1994), MPEP 2181 provides assistance in the matter, stating in part:

"Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination." (Emphasis added)

Thus, in addition to the clearly erroneous fact findings described above, the Examiner has apparently failed to examine Claims 16-20 in accordance with controlling law.

Claims 11-14 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,956,693, issued to Geerlings (hereinafter referred to as "Geerlings"). This ground of rejection is respectfully traversed for the following reasons.

Claim 11 is a method claim having five basic steps:

(3)

- 1) automatically generating;
- 2) converting into HTML;
- 3) spooling HTML;
- 5) making a service request; and
- 6) transmitting HTML.

Geerlings shows none of these steps. With regard to the first step (i.e., automatically generating a report), the Examiner cites column 3, lines 10-12 and column 5, lines 33-40. Neither of these citations teaches "automatically generating a report by a database management system in response to a sensed signal at a first predetermined time" which is limiting of Claim 11.

With regard to the second step, the Examiner offers three citations which tangentially mention Internet communication. However, none of these citations says anything about conversion of a report into HTML, so it is problematic to determine the Examiner's intention with regard to these citations. Because the

Internet facilitates communication using a wide variety of formats, conversion to HTML is not inherent in Internet communication. Guidance with regard to the matter of inherency is provided by MPEP 2112, which states in part:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). >"To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' "In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

As to the third step, the Examiner adds a fourth citation (i.e., column 5, lines 33-57) which also says nothing of "spooling said HTML display page within a repository".

Step four recites "making a service request from said user terminal to said data base management system". In his rejection, the Examiner mysteriously cites column 2, lines 26-27, which states (full sentence given):

In particular, initiation of a desired communication may be based on a specific purchase made by a recipient or the passage of a certain length of time from a specific shopping activity by the recipient, or the last inquiry made by the recipient and seasonal activity by recipients, for example.

It is very surprising that the Examiner could consider this to be "making a service request from said user terminal to said data base management system".

The citations regarding the fifth step are equally confusing. Therefore, the rejection of Claim 11 and claims depending therefrom is respectfully traversed for failure of Geerlings to teach the elements of the claimed invention.

The rejections of Claims 12-14 are similarly defective and respectfully traversed for the same reasons.

The Examiner has rejected Claim 10 under 35 U.S.C. 103 as being unpatentable over Pollard in view of Geerlings. This ground of rejection is respectfully traversed for failing to show all of the claimed elements as explained above. Furthermore, the Examiner has failed to show motivation or reasonable likelihood of success of the alleged combination of Pollard and Geerlings as required by MPEP 2143. Specifically, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare reports to be delivered to a user terminal comprising an industry compatible personal computer having a web browser, since by definition such computers are ubiquitous within the

computer art, and as such it would have been obvious to prepare reports that were capable of being received and displayed on such machines.

In other words, because computers exist, anything done using those existing computers is obvious. This finding is both incorrect as a matter of law and incorrect as a matter of logic. The rejection of Claim 10 is therefore respectfully traversed.

The Examiner utilizes the same defective reasoning with regard to his rejection of Claim 20. Therefore, the rejection of Claim 20 is respectfully traversed.

A similar defect in the application of logic and law occurs with the Examiner's rejection of Claims 5 and 19. He states:

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It would have been obvious to one of ordinary skill at the time of the invention to incorporate the CLASSIC MAPPER database management system, since it is admitted as prior art that CLASSIC MAPPER is one of the most successful database management systems (see page 4, lines 9-12).

In other words, because Classic MAPPER exists, it is obvious to use it to prepare and distribute the printed, hard copy reports of Pollard. The rejection of Claims 5 and 19 is respectfully traversed.

The rejection of Claim 15 utilizes the same defective logic and is therefore similarly respectfully traversed.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment

and allowance of Claims 1-20, as amended, being the only pending claims.

Respectfully submitted,

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